



3510-16-P

## DEPARTMENT OF COMMERCE

### United States Patent and Trademark Office

#### Matters Related to First Inventor to File

**ACTION:** Proposed collection; comment request.

**SUMMARY:** The United States Patent and Trademark Office (USPTO), as part of its continuing effort to reduce paperwork and respondent burden, invites the general public and other Federal agencies to comment on proposed and/or continuing information collections, as required by the Paperwork Reduction Act of 1995, Pub. L. 104–13 (44 U.S.C. 3506(c)(2)(A)).

**DATES:** Written comments must be submitted on or before **[INSERT DATE 60 DAYS AFTER THE DATE OF PUBLICATION IN THE FEDERAL REGISTER]**.

**ADDRESSES:** Written comments may be submitted by any of the following methods:

- *Email:* [InformationCollection@uspto.gov](mailto:InformationCollection@uspto.gov). Include “0651-0071 comment” in the subject line of the message.
- *Federal Rulemaking Portal:* <http://www.regulations.gov>.

- *Mail:* Marcie Lovett, Records Management Division Director, Office of the Chief Information Officer, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313–1450.

**FOR FURTHER INFORMATION CONTACT:** Requests for additional information should be directed to Raul Tamayo, Senior Legal Advisor, Office of Patent Legal Administration, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450; by telephone at 571-272-7728; or by e-mail to [Raul.Tamayo@uspto.gov](mailto:Raul.Tamayo@uspto.gov) with “0651-0071 comment” in the subject line. Additional information about this collection is also available at <http://www.reginfo.gov> under “Information Collection Review.”

## **SUPPLEMENTARY INFORMATION:**

### **I. Abstract**

The Leahy-Smith America Invents Act (AIA) was enacted into law on September 16, 2011. See Pub. L. 112-29, 125 Stat. 283 (2011). Section 3 of the AIA, *inter alia*, amended 35 U.S.C. 102 and 103 consistent with the objectives of the AIA, including the conversion of the United States patent system from a “first to invent” system to a “first inventor to file” system. The changes in section 3 of the AIA went into effect on March 16, 2013, but apply only to certain applications filed on or after March 16, 2013.

37 CFR 1.55(j), 1.78(a)(6) and 1.78(d)(6) require information needed to assist the USPTO in determining whether an application is subject to 35 U.S.C. 102 and 103 as amended by the AIA or 35 U.S.C. 102 and 103 in effect on March 15, 2013. 37 CFR 1.110 requires information needed to identify the inventor, and ownership on the

effective filing date, of each claimed invention in an application or patent with more than one named inventor, when necessary for purposes of a USPTO proceeding. 37 CFR 1.130, 1.131, and 1.132 provide for the submission of affidavits or declarations needed (i) to show that a disclosure was by the inventor or joint inventor, or was by a party who obtained the subject matter from the inventor or a joint inventor (1.130), (ii) to show that there was a prior public disclosure by the inventor or a joint inventor, or by a party who obtained the subject matter from the inventor or a joint inventor (1.130), (iii) to establish prior invention or to disqualify a commonly owned patent or published application as prior art (1.131), or (iv) to submit evidence to traverse a rejection or objection on a basis not otherwise provided for (1.132).

The USPTO accounts for both electronic and paper submissions in this collection.

## **II. Method of Collection**

Electronically when using the USPTO online filing system EFS-Web, or by mail, facsimile, or hand delivery.

## **III. Data**

*OMB Number:* 0651–0071.

*IC Instruments and Forms:* The individual instruments in this collection, as well as any associated forms, are listed in the hourly cost burden table below.

*Type of Review:* Revision of a Previously Existing Information Collection.

*Affected Public:* Individuals or households; businesses or other for-profits; and not-for-profit institutions.

*Estimated Number of Respondents:* The USPTO estimates that it will receive a total of approximately 50,150 responses per year for this collection, of which approximately 12,538 will be filed by small entities. The USPTO estimates that approximately 48,646 of the responses for this collection will be submitted electronically via EFS-Web.

These estimates are based on the Agency's long-standing institutional knowledge of and experience with the type of information collected by these items.

*Estimated Time per Response:* The USPTO estimates that the responses in this collection will take the public from 2 to 10 hours to complete. This includes the time to gather the necessary information, create the document, and submit the completed request to the USPTO. Specifically, the USPTO estimates that: (1) preparing an affidavit or declaration under 37 CFR 1.130, 1.131, or 1.132 will require, on average, 10 hours; (2) identifying under 37 CFR 1.55(j), 1.78(a)(6), or 1.78(d)(6) whether there is any claim or subject matter not disclosed in the prior foreign, provisional, or non-provisional application will require, on average, 2 hours; and (3) identifying under 37 CFR 1.110 inventorship and ownership of the subject matter of claims will require, on average, 2 hours. The USPTO calculates that, on balance, it takes the same amount of time to gather the necessary information, create the document, and submit it to the USPTO, whether the applicant submits the information in paper form or electronically.

These estimates are based on the Agency's long-standing institutional knowledge of and experience with the type of information collected and the length of time necessary to complete responses containing similar or like information.

*Estimated Total Annual Respondent Burden Hours:* 340,300 hours.

*Estimated Total Annual Respondent (Hourly) Cost Burden:* \$132,376,700. The USPTO expects that attorneys will complete the instruments associated with this information collection. The professional hourly rate for attorneys is \$389. Using this hourly rate, the USPTO estimates \$132,376,700 per year for the total hourly costs associated with respondents.

IC Number	Information Collection Instrument	Estimated time for response (minutes) (a)	Estimated Annual Responses (b)	Estimated annual burden hours (a) x (b) / 60 = (c)	Rate (\$/hr)
1	Electronic Submissions Under 37 CFR 1.55(j)	120	9,700	19,400	\$389.00
1	Submissions Under 37 CFR 1.55(j)	120	300	600	\$389.00
2	Electronic Submissions Under 37 CFR 1.78(a)(6)	120	7,760	15,520	\$389.00
2	Submissions Under 37 CFR 1.78(a)(6)	120	240	480	\$389.00
3	Electronic Submissions Under 37 CFR 1.78(d)(6)	120	1,940	3,880	\$389.00
3	Submissions Under 37 CFR 1.78(d)(6)	120	60	120	\$389.00
4	Electronic Identification of Inventorship and Ownership of the Subject Matter of Individual Claims under 37 CFR 1.110	120	146	292	\$389.00
4	Identification of Inventorship and Ownership of the Subject Matter of Individual Claims under 37 CFR 1.110	120	4	8	\$389.00
5	Electronic Rule 1.130, 1.131, and 1.132 Affidavits or Declarations	600	29,100	291,000	\$389.00
5	Rule 1.130, 1.131, and 1.132 Affidavits or Declarations	600	900	9,000	\$389.00
<b>Total</b>	.....	.....	<b>50,150</b>	<b>340,300</b>	.....

*Estimated Total Annual (Non-hour) Cost Burden:* \$8,475.50. The USPTO estimates that the total annualized (non-hour) cost burden for this collection is due to postage costs of \$8,475.50 per year. Customers may incur postage costs when submitting some of the

items covered by this collection to the USPTO by mail. The USPTO expects that approximately 97 percent of the responses in this collection will be submitted electronically. Of the remaining 3 percent, the vast majority--98 percent--will be submitted by mail, for a total of 1,474 mailed submissions. The average first class USPS postage cost for these items is estimated at \$5.75; the cost of a one pound mailed submission in a flat rate envelope. Therefore, the USPTO estimates that the postage costs for the mailed submissions in this collection will total \$8,475.50.

#### **IV. Request for Comments**

Comments are invited on:

- (a) Whether the proposed collection of information is necessary for the proper performance of the functions of the agency, including whether the information shall have practical utility;
- (b) the accuracy of the agency's estimate of the burden (including hours and cost) of the proposed collection of information, including the validity of the methodology and assumptions used;
- (c) ways to enhance the quality, utility, and clarity of the information to be collected; and
- (d) ways to minimize the burden of the collection of information on respondents, including through the use of automated collection techniques or other forms of information technology, e.g., permitting electronic submission of responses.

Comments submitted in response to this notice will be summarized or included in the request for OMB approval of this information collection; they will also become a matter

of public record.

Dated: June 1, 2015.

**Marcie Lovett,**

*Records Management Division Director,*

*USPTO,*

*Office of the Chief Information Officer.*

**BILLING CODE 3510-16-P**

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